

REMARKS

This is a full and timely response to the outstanding final Office Action mailed March 3, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Objections

Claim 5 has been objected for comprising an informality. In response to the objection, Applicant has amended claim 5 to change “a print ready version” to “the print ready version”. In view of that claim amendment, Applicant respectfully submits that the claims are not objectionable and respectfully requests that the objection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

A. Rejection of Claims 1, 3, 5-8, 13, 14, 18, and 20-37

Claims 1, 3, 5-8, 13, 14, 18, and 20-37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Strobel, et al.* ("Strobel," U.S. Pat. No. 6,751,732) in view of *Walker, et al.* ("Walker," U.S. Pat. No. 6,111,953). Applicant respectfully traverses this rejection.

In the Office Action, it is argued that Strobel teaches each of the limitations of Applicant's independent claims except "translating/decrypting the document at the portable device." In view of that, the Office Action relies upon the Walker reference, which it is argued teaches "transmitting an encrypted document from a printer to a computing device wherein the computing device translates/decrypts the encrypted document." Applicant disagrees that Walker teaches transmitting anything "from a printer" and further disagrees that Walker teaches transmitting an untranslated document for translation into a "print ready format".

Walker discloses apparatus for authenticating a document. As described by Walker, an authentication/verification device, either in stand-alone form or integrated with a computer, comprises a cryptoprocessor 120, 220. *Walker*, column 3, lines 57-67; column 4, lines 41-53. The cryptoprocessor receives “document variable information” entered by a user and transmits an “encrypted authenticatable code” that can be stamped on a hard copy document (e.g., check) by a stamper 150, 250. *See, e.g., Walker*, column 4, lines 54-65. The code affixed to the document (e.g., check) is a human-readable string of characters that may be input into the authentication/verification device in order to verify the authenticity of the document. *Walker*, column 6, lines 9-14.

As is indicated in the Office Action, Walker discloses an embodiment in which the cryptoprocessor is located remotely from the point of verification and authentication. As described by Walker:

Another embodiment of the invention, which uses the procedure outlined just above, is shown schematically in FIG. 5. In this embodiment, the cryptoprocessor 520 is located remotely from both the point of authentication and the point of verification, and communicates with the authentication/verification device 501 over a telephone line 580 through communication ports 511 and 512. Cryptoprocessor 520, controlled by a CPU 530, accesses keys stored in the data storage device 515. Cryptoprocessor 520 and/or data storage device 515 may be located within a secure perimeter 521. As in the previous embodiments, information from a document 100 is input to the device 501; for example, selected fields on the document are scanned by a document reader 502. If the document is to be authenticated, the document-specific data is received by the CPU 510 which transmits the data to the cryptoprocessor and then receives the encrypted

data from the cryptoprocessor to be printed on the document by the printer 550. If the document is to be verified, the device 501 transmits the stamped code on the document to the cryptoprocessor and then displays the decrypted information on the display device 503. An advantage of this arrangement is that the cryptoprocessor and keys are maintained in a single secure location.

Walker, column 7, line 61 to column 8, line 15.

Applicant asserts that, none of the embodiments described above, including those of the above excerpt, involve “transmitting an encrypted document from a printer to a computing device,” as argued by the Examiner. In the reproduced excerpt, Walker only describes the “CPU 510” of an authenticating/verifying device 501 transmitting “document-specific data” entered by a user to the “cryptoprocessor,” and then receiving from the cryptoprocessor data to be printed on the document by a printer 550 (i.e., a document “stamper”). Therefore, no printer is transmitting any information to any device. For at least that reason, there would be no motivation for a person having ordinary skill in the art to transmit a document from Strobel’s printer to Strobel’s mobile device. Significantly, beyond failing to teach a printer transmitting a document, Walker does not even teach transmitting a document at all. Instead, it is only the “document-specific data,” i.e., the authentication/verification data to be stamped on a document (e.g., check) that is transmitted in the Walker system.

In view of the above, Walker cannot be said to provide motivation for modifying the Strobel system to transmit a document from Strobel’s printer to Strobel’s mobile device. Given that each remaining independent claim specifies transmitting a document from a printer to a portable computing device or receiving a document from a printing device with

a portable computing device, the Strobel/Walker combination fails to render Applicant's claims obvious.

As a further matter, Applicant notes that neither Strobel nor Walker contemplates the concept of "untranslated" documents or translating those documents to yield "print ready" documents. Instead, both Strobel and Walker limit their disclosures to encryption.

In view of the lack of disclosure as to untranslated documents and translating those documents into print ready format, both Strobel and Walker fail to teach or suggest "receiving with a printer an untranslated document to be printed" and "receiving with the printer a print ready version of the document from the portable computing device" as provided in claim 1; "receiving with a portable computing device an untranslated document from a nearby printing device", "translating the document into a print ready format on the portable computing device" and "transmitting the translated document from the portable computing device back to the printing device so that the printing device can generate a hard copy of the document" as provided in claim 13, "a security manager that is configured to facilitate transmission of a document that cannot be printed in its present form to a nearby portable computing device and further configured to receive a print ready version of the document from the portable computing device" as provided in claim 23; a document translator that is configured to receive an untranslated document transmitted from a nearby printing device, translate the document into a print ready format, and facilitate transmission of the print ready document back to the printing device" as provided in claim 28; or "logic configured to receive an untranslated document from a nearby printing device" and "logic configured to facilitate transmission of the translated document back to the printing device so that the printing device can generate a

hard copy of the document” as provided in claim 36. Those claims are therefore further allowable over the Strobel/Walker combination for lack of disclosure regarding unprotected documents and translation into print ready format. Applicant notes that, as is well known in the printing arts, the “translation” of documents into a “print ready format” is distinct from document encryption/decryption. Furthermore, Applicant notes that it is well established in the law that claim terms are to be *interpreted in light of the specification*. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), *aff’d*, 517 U.S. 370, 38 USPQ2d 1461 (1996) (“Claims must be read in view of the specification, of which they are a part”). Applicant’s specification draws a clear distinction between translation into a print ready format and encryption.

B. Rejection of Claims 10, 11, 15, and 16

Claims 10, 11, 15, and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Strobel* and *Walker*, and further in view of *Roberts, et al.* (“Roberts,” U.S. Pat. No. 6,650,431). Applicant respectfully traverses this rejection.

As is identified above, Strobel and Walker do not teach several aspects of Applicant’s claims. In that Roberts does not remedy the deficiencies of the Strobel and Walker reference, Applicant respectfully submits that claims 10, 11, 15, and 16, which depend from claims 6 and 13, are allowable over the Strobel/Walker/Roberts combination for at least the same reasons that claims 6 and 13 are allowable over Strobel/Walker.

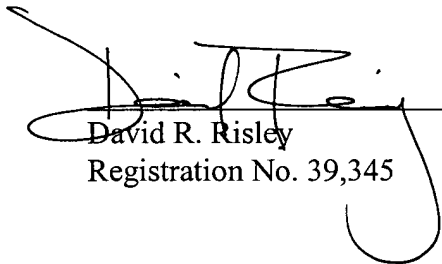
III. Canceled Claims

Claims 2, 4, 9, 12, and 17-22 have been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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